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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,090	12/21/2005	Naoyuki Tokuda	P7085GUSD	5877

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JACOBSON HOLMAN PLLC
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WASHINGTON, DC 20004

EXAMINER

KENNEDY, ADRIAN L

ART UNIT	PAPER NUMBER
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2129

MAIL DATE	DELIVERY MODE
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05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,090

Applicant(s)

TOKUDA ET AL.

Examiner

ADRIAN L. KENNEDY

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Examiner's Detailed Office Action

1. This Office Action is responsive to **Amendment After Non-Final** filed **February 11, 2008**.
2. **Claims 6-20** will be examined.

Claim Objections

3. Claims 7-11 and 13-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokuda et al. (An Online Tutoring System for Language Translation, referred to as Tokuda).

Regarding claim 6:

Tokuda teaches,

(New) A computer-implemented dialogue learning system for teaching a language
(Tokuda: Page 46, Left Column).

Regarding the remainder of that applicant's claimed invention of claim, the examiner takes the position that in being only "capable of" and "configured to" that the applicant's may or may not do anything that it is "capable of" and "configured to" do. Furthermore, the examiner has found that the only real requirement of the prior art is that it be a "computer implemented dialogue learning system for teaching language". Finally, if the applicant actually intends for the scope of the claimed invention to be more than just "capable of" and "configured to" do certain actions, this language should be changed to indicate that the claimed invention does actually perform said actions.

Regarding claim 12:

Tokuda teaches,

(New) An automated computer-implementable dialogue learning system for teaching a language (Tokuda: Page 46, Left Column).

Regarding the remainder of that applicant's claimed invention of claim, the examiner takes the position that in being only "capable of" and "configured to" that the applicant's may or may not do anything that it is "capable of" and "configured to" do. Furthermore, the examiner has found that the only real requirement of the prior art is that it be an "automated computer implementable dialogue learning system for teaching language". Finally, if the applicant actually intends for the scope of the claimed invention to be more than just "capable of" and "configured to" do certain actions, this language should be changed to indicate that the claimed invention does actually perform said actions.

Response to Arguments

Applicant's arguments filed on February 11, 2008 have been fully considered but are found to be non-persuasive. The unpersuasive arguments made by the Applicant are stated below:

In reference to Applicant's argument

As claims 1-5 have been cancelled herein, the rejections are technically moot. However, with respect to new claims 6-20, Applicants provide the following remarks.

Examiner's response:

The examiner has considered the applicant's above arguments and has presented a new grounds of rejection as set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tokuda et al. is cited for his online tutoring system for language translation. Huang et al. is cited for his syntactical approach to diagnosing multiple bugs in an intelligent tutoring system

Examiner's Opinion:

The examiner has considered the applicant's arguments in light of the claimed invention. Furthermore, the examiner respectfully reminds the applicant that **“during examination, the claims must be interpreted as broadly as their terms reasonably allow”**. (MPEP 2111.01 [R-5] I)

It is the goal of the Examiner to move the applicant's claimed invention towards allowability. However, as presently claimed, the applicant's claimed invention is substantially broad and is broad enough to read on the prior art of record. The examiner respectfully request that the applicant consider what the invention is, and where the line between the prior art (cited by the examiner and/or known by the applicant) and the applicant's intended invention lay. This request is made so the examiner can help the applicant arrive at claim language that not only traverses the language taught in the presently pending and/or previously disclosed prior art, but also traverses concepts taught (or suggested) in prior art known by the examiner and/or applicant which has not been cited. Also, the examiner is more than willing to have an interview with applicant, but requests that the applicant disclose what he or she considers to be the most inventive portion of the claimed and/or disclosed invention.

Should the applicant choose to amend, the Examiner respectfully suggests that the applicant indicate that the applicants claimed system actually performs the actions which it was previously indicated as only being capable or configure to perform because being "capable of" or "configured to" indicates that certain action may or may not be required to actually take place. The examiner suggests that the applicant remove this language and replace it with language along the lines of a "system for teaching a language which [generates]...", and where "said extraction rules extract" (The previously cited suggestions are not a recitation of allowable subject matter, but are rather subject matter disclosed/claimed by the applicant which will help further distinguish the claimed

invention from the prior art. Furthermore, any amendment will require further searching of the prior art.).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claims 6-20 are rejected.

Claims 7-11 and 13-20 are objected as being dependent on a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian L. Kennedy whose telephone number is (571) 270-1505. The examiner can normally be reached on Mon -Fri 8:30am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent can be reached on (571) 272-3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALK

David Vincent
Supervisory Patent Examiner
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/Joseph P. Hirl/

Primary Examiner, Art Unit 2129